REMARKS

Applicants request reconsideration of this application in view of the present Amendment.

Claims 1-20 and 31 are cancelled. Claims 21-30 are pending. Claims 21, 24, 27 and 30 are amended.

35 U.S.C. § 102(e)--*Lebl et al.* (U.S. 6,045,755)

Amended claim 21 recites an apparatus for transferring and releasing air-sensitive and/or moisture-sensitive and/or light-sensitive substances from a synthesis chamber to a test reactor and includes a test reactor, wherein the test reactor is a stirred reactor or a pressure vessel having suitable stirring devices. The apparatus as defined in claim 21 also includes means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance. Lebl discloses neither an apparatus including a test reactor, wherein the test reactor is a stirred reactor or a pressure vessel having suitable devices, nor a means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance.

Lebl discloses an integrated robot apparatus for performing combinatorial chemistry synthesis protocols. In contrast to the apparatus described by amended claim 21, the Lebl apparatus does not include a test reactor. Further, because Lebl does not disclose a test reactor he does not disclose a test reactor that is a stirred reactor or a pressure vessel having suitable stirring devices. The Lebl device prepares its combinatorial products in reaction vessels that can be enclosed in sub-enclosures capable of retaining an inert atmosphere. Lebl does not, however, disclose a test reactor to which its combinatorial products could be transferred from its reaction vessel or sub-enclosure for testing. Lebl specifically states:

> "After the desired number of building block addition steps, the final compound is present in the reaction vessel attached to the solid-phase support. The final compounds can be utilized either directly attached to their synthetic supports, or alternatively, can be cleaved from their supports." Lebl, column 9, lines 32-37.

This is the limit of what Lebl discloses as the functionality of his apparatus. Lebl does not disclose any ability within his apparatus for testing his final compound. Thus, the completed

synthesis of the final compounds is the limit of the capability of Lebl's apparatus and also the limit of his disclosure. As further evidence that the generation of combinatorial compounds is the limit of the capability of Lebl's apparatus, he mentions at the end of his experimental section that, as a *post-processing* step, *i.e.*, post-apparatus, his experimental components were *removed* and analyzed by *separate* liquid chromatography and mass spectrometry instruments. *See* Lebl, column 41, lines 53-58.

In addition to the fact that Lebl does not disclose a test reactor, Lebl further does not disclose means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance. The Office Action indicates that Lebl discloses means for freeing within the test reactor at col. 13, lines 33-40. However, what is disclosed at col. 13, lines 33-40 is simply a syringe fluid manipulation tool for manipulating fluid transfer syringes. This syringe tool is not disclosed to be capable of destroying a means for protecting the substance. The syringe tool is not disclosed to be capable of destroying anything.

Because Lebl discloses neither a test reactor, wherein the test reactor is a stirred reactor or a pressure vessel having suitable stirring devices *nor* a means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance, amended claim 21 is not anticipated by Lebl under 35 U.S.C. § 102(e). Dependent claims 22-26 and 29 contain features that further distinguish those claims from the disclosure of Lebl and, thus, also are not anticipated by Lebl under 35 U.S.C. § 102(e).

Amended claim 30 also defines an apparatus for transferring and releasing air-sensitive and/or moisture-sensitive and/or light-sensitive substances from a synthesis chamber to a test reactor and includes a test reactor, and a means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance. As discussed above for amended claim 21, Lebl neither disclose a test reactor *nor* a means for freeing, within the test reactor, the substance from the means for protecting the substances, wherein said means are capable of destroying said means

for protecting the substance. Thus, amended claim 30 is not anticipated by Lebl under 35 U.S.C. § 102(e).

35 U.S.C. § 102(e)--*Guan et al.* (U.S. 6,149,882)

Amended claim 27 recites an apparatus for transferring and releasing air-sensitive and/or moisture-sensitive and/or light-sensitive substances from a synthesis chamber to a test reactor. The apparatus of amended claim 27 includes the following elements:

- a synthesis chamber for preparing an air-sensitive and/or moisture sensitive and/or light-sensitive substances in closed vessels;
- connection lines in fluid communication between the opening of the closed vessel and the test reactor; and
- means for transferring the substance in the closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor.

Guan does not disclose any of these elements of claim 27.

Guan discloses an apparatus and method for rapid analysis of members of a combinatorial library. However, Guan does not disclose a synthesis chamber capable of preparing light-, air-, or moisture-sensitive substances *in closed vessels*. The Office Action implies that the fluid mixing unit of Guan (22) is a synthesis chamber. However, the fluid mixing unit of Guan (22) simply directs test fluids to flow through a manifold (58) into a feed line (60). Because Guan's fluid mixing chamber simply directs test fluid flow into a single feed line, the mixing chamber can hardly be characterized as a synthesis chamber. Further, no closed vessels are disclosed by Guan for preparing light-, air-, or moisture-sensitive substances within the fluid mixing unit. Because Guan does not disclose closed vessels having an opening, Guan also does not disclose connection lines in fluid communication between the opening of the closed vessel and the test reactor *or* means for transferring the substance in the closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor.

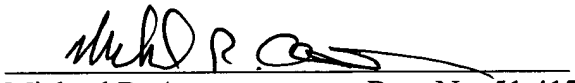
Because Guan discloses neither a synthesis chamber for preparing an air-sensitive and/or moisture sensitive and/or light-sensitive substances in closed vessels; connection lines in fluid communication between the opening of the closed vessel and the test reactor; *nor* means for

transferring the substance in the closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor, amended claim 27 is not anticipated by Guan under 35 U.S.C. § 102(e). Dependent claim 28 contains features that further distinguish the claim from the disclosure of Guan and, thus, also is not anticipated by Guan under 35 U.S.C. § 102(e).

Conclusion

For the reasons discussed above, Applicants respectfully submit that the application is in condition for allowance and allowance is requested.

Respectfully submitted,



Michael R. Asam Reg. No. 51,417
Jones Day
North Point
901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7770